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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,068	09/09/2003	William E. Launius JR.	WEL002	5487

27789 7590 01/25/2005
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EXAMINER

CRANE, DANIEL C

ART UNIT PAPER NUMBER

3725

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/658,068

Applicant(s)

LAUNIUS, WILLIAM E.

Examiner

Daniel C Crane

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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BASIS FOR REJECTIONS

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (c) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

DRAWING OBJECTION

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the feature where the dowels extend partially through the thickness of the male jaw and less than the thickness of the male jaw above the mating surface must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must

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be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

REJECTION OF CLAIMS ON FORMAL MATTERS

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Failure to provide a description of the construction where the "dowels extend partially through the thickness of said male jaw and less than the thickness of said male jaw above said mating surface" renders the original disclosure incomplete and insufficient.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Failure to provide antecedence for the "lateral axis" and the "longitudinal axis" renders the subject matter indefinite. Use of the term "typically" is not a positive recitation and leaves open other vague interpretations.

REJECTION OF CLAIMS OVER PRIOR ART

Claims 1, 2, 4, 6 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Bowman (1,399,101). Bowman shows that the female die 7 is provided with holes to receive dowels 6 of the male die 1 so as to accurately align the two dies. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowman (1,399,101) in view of Zepp (3,866,459). Bowman does not show that the dies are provided with diagonally arranged dowels. This is a common expedient in the tool art as evidenced by Zepp in Figures 3 and 4 for the purpose of diagonally aligning the dies. It would have been obvious to

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the skilled artisan at the time of the invention to have modified Bowman's dowels 6 by arranging the dowels in a diagonal orientation as taught by Zepp so as to facilitate a diagonal alignment.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bowman (1,399,101) in view of St. Mars (1,051,777). Bowman shows that the dowels are integral with the male die. St. Mars shows the male die to be fabricated from separate parts, dowels and the male die, per se. It would have been obvious to the skilled artisan, having the benefit of St. Mars' teaching, to have modified Bowman's dowels by arranging them as taught by St. Mars so as to facilitate the assembly of the male dies from separate parts.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bowman (1,399,101) in view of Darling (2,793,859). Bowman does not show that the dowels have rounded ends. This is shown by Darling, such facilitating the inserting into the dowel holes. It would have been obvious to the skilled artisan at the time of the invention to have modified Bowman's dowels by rounding the ends of the dowels using the features taught by Darling for the noted motivation.

Claims 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowman (1,399,101) in view of Faull (3,234,838). Bowman illustrates dies 1, 7 where one of the dies is provided with dowels and the cooperating die is provided with dowel holes. Faull shows a dowel/hole construction where one die 10 is provided with a dowel 14 and a hole 15 and the cooperating die 10.1 is provided with a dowel 14.1 and hole 15.1. This "insures precise registry"

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(column 2, lines 1-3, of Faull) of the dies. It would have been obvious to the skilled artisan at the time of the invention to have modified Bowman's dowels and holes by arranging the dowels and holes using the concepts taught by Faull for the noted motivation. The skilled artisan would have recognized the need to round the dowel ends so as to facilitate insertion of the dowels in the holes.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bowman and Faull as applied to claims 10-13 above, and further in view of Zepp (3,866,459). Bowman, as modified, does not show that the dies are provided with diagonally arranged dowels. This is a common expedient in the tool art as evidenced by Zepp in Figures 3 and 4 for the purpose of diagonally aligning the dies. It would have been obvious to the skilled artisan at the time of the invention to have modified Bowman's dowels 6 by arranging the dowels in a diagonal orientation as taught by Zepp so as to facilitate a diagonal alignment.

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honeycutt (4,116,037) in view of Bowling (6,234,000). Honeycutt illustrates the basic claimed method where a tubing section, which is usable as a hollow axle, is straightening by pressing two dies together to impart a straight shape of the dies to the axle. Honeycutt does not use dies having locating dowels and corresponding holes nor does Honeycutt rotate the axle within the dies between successive shaping operations. This is known in the art as envisioned by Bowling where tubing can be straightened and rounded by pressing dies with cooperating dowels and holes so as to accurately locate the dies during the pressing operation. Further, Bowling foresees

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the need to rotate the tubing to accurately round and straighten the tubing throughout its circumference. It would have been obvious to the skilled artisan at the time of the invention to have modified Honeycutt's method by using dies as shown by Bowling and rotate the tubing as taught by Bowling for the noted motivation. As to the cleaning, such would be a normal manufacturing provision. Marking the positions would also have been obvious to the skilled artisan since such would have been within the purview of the manufacturing operator.

PRIOR ART CITED BY EXAMINER

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

RESPONSE BY APPLICANT(S)

Applicant(s) response to be fully responsive and to provide for a clear record must specifically point out how the language of the claims patentably distinguishes them from the references, both those references applied in the objections and rejections and those references cited in view of the state of the art in accordance with 37 CFR 1.111 (a), (b) and (c).

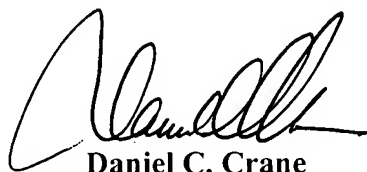
INQUIRIES

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner D. Crane whose telephone number is (571) 272-4516. The examiner's office hours are 6:30AM-5:00PM, Tuesday through Friday.

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Documents related to the instant application may be submitted directly to Group 3700 by facsimile transmission at all times. Applicant(s) is(are) reminded to clearly mark any transmission as "DRAFT" if it is not to be considered as an official response. The Group 3725 Facsimile Center number is **(703) 872-9306**.

DCCrane
January 21, 2005

A handwritten signature in black ink, appearing to read 'D. Crane', with a stylized, flowing script.

Daniel C. Crane
Primary Patent Examiner
Group Art Unit 3725